

REMARKS

Claims 1-33 are pending in this application. Claims 1-33 stand rejected. By this Amendment, claims 1 and 7 have been amended. The amendments made to claims 1 and 7 do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to claims 1, 7, 8, and 12 have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicants respectfully submit that each of the pending claims is in immediate condition for allowance.

The Office Action rejects claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,796,445 (“Nomura”) in view of U.S. Patent No. 5,473,384 (“Jayant”). Applicants respectfully request reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in combining them, would have arrived at the invention claimed by the Applicants. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are

of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining Nomura and Jayant is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would have modified the components in Nomura to reflect the process disclosed in Figure 6 of Jayant, because "frequency components in edge pixel and non-edge pixel are different and they can be filtered by different filter processing such as suggested by Jayant." See Office Action, at 3.

This assertion, however, is merely conclusory. The simple statement that the process disclosed by Jayant can be performed does not say how or why a person of ordinary skill in the art would be motivated to modify Nomura in light of Jayant.

The Office Action only asserts that Nomura can be modified to process in the manner disclosed in Jayant. It does not show why one of ordinary skill in the art would be motivated to actually do so. That is to say, the Office Action does not explain why a person of skill in the art would not have been motivated to rearrange the components of Nomura to reflect the arrangement shown in Jayant.

The Office Action's assertions are general and conclusory. Simply asserting that what is taught in Jayant is well-known to one of skill in the art, without more, does not provide the Applicants with a sufficiently clear and particular showing of a motivation to combine.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in Nomura in light of Jayant. As a result, the Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1 through 33, and that the objection to those claims under Section 103 should be withdrawn.

Further, the Office Action recognizes that Nomura fails to disclose every feature of the present invention, but asserts that the present invention is obvious from the combination of Jayant and Nomura as discussed above. However, Jayant removes a random noise that occurs in the image data whereby it is characterized by

extraction of the noise which may partially and appropriately be subjected to different filtrations.

In contrast, according to the present invention, different partial extractions and filtrations are used for each target. As such, the present invention could never be conceived from the combination of Jayant and Nomura.

Applicants respectfully request that the Examiner consider the references cited in the IDS filed January 7, 2002, and return an initialed copy of the PTO-1449 Form with the next communication on this application. For the Examiner's convenience, another copy of the January 7, 2002 PTO-1449 Form is enclosed herewith.

Applicants also respectfully request that the Examiner consider the references cited in the IDS filed July 12, 2002, and return an initialed copy of the Form PTO/SB/08A with the next communication on this application. For the Examiner's convenience, another copy of the July 12, 2002 Form PTO/SB/08A is enclosed herewith.

Applicants respectfully request the Examiner acknowledge receipt of the a certified copy of the priority document filed January 7, 2002.

Applicants have responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this

application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: September 30, 2004

Respectfully submitted,

By _____
Ian R. Blum

Registration No.: 42,336
DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicants

IRB/mgs
Attachments